



152 AF

1 RECORD OF ORAL HEARING

2 UNITED STATES PATENT AND TRADEMARK OFFICE

3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES

6  
7 Ex parte EDWIN NUN,  
8 MARKUS OLES, and  
9 ARNE LANG

10  
11 Appeal 2008-3847  
12 Application 10/506,993  
13 Technology Center 1700

14  
15  
16 Oral Hearing Held: October 22, 2008

17  
18  
19 Before BRADLEY R. GARRIS, PETER F. KRATZ, and  
20 MICHAEL P. COLAIANNI, Administrative Patent Judges

21  
22 ON BEHALF OF THE APPELLANTS:

23  
24 HARRIS PITLICK, ESQ.  
25 Oblon, Spivak, McClelland,  
26 Maier & Neustadt, P.C.  
27 1940 Duke Street  
28 Alexandria, Virginia 22314  
29  
30  
31  
32  
33  
34

1           The above-entitled matter came on for hearing on Wednesday,  
2   October 22, 2008, commencing at 1:28 p.m., at the U.S. Patent and  
3   Trademark Office, 600 Dulany Street, 9th Floor, Hearing Room D,  
4   Alexandria, Virginia, before Kenyan C. Hopchas, Notary Public.

5           JUDGE GARRIS: Good afternoon, Mr. Pitlick.

6           MR. PITLICK: Good afternoon. We have two rejections here.  
7   One with anticipation over a Huffer reference of all but two of the claims,  
8   the second rejection leaves those remaining two claims, Huffer and Bauman,  
9   et al.

10          What we have here are basically claims 11 and 17, the two  
11   independent claims. And as we have pointed out in our briefs, the Examiner  
12   basically has ignored all the process limitations and basically says that the  
13   prior art is no different from the Huffer.

14          Now, obviously, it is clear that to the extent the process  
15   limitations don't add any structure to the product, the examiner is right,  
16   because we all know if the product is the same it's the prior art that is --  
17   made by a different process, but here various process limitations do have  
18   structural implications.

19          For example, we have a molding and it is in claim 11,  
20   softenable or moltenable, so therefore, it has to be a material that is capable  
21   of being softened or melted.

22          And it also has to contain at least an organic material, and claim  
23   17 as well has to require that.

24          And so what you are left with, and if you call the molding itself,  
25   the molding composition, you can refer to that argument saying that it is a  
26   substrate.

1           If you refer to that molding composition as a substrate the  
2 particles that are embedded directly in the substrate and they will stick out to  
3 such an extent as recited in the claims.

4           Huffer has a coating which has particles. Now, so the particles  
5 are not embedded in the substrate, the part of the coating, as we pointed out  
6 as well, the substrate does not appear to be either moldable, et cetera.

7           Now, as far as Bauman goes, the examiner is only relying on  
8 the various limitations of claims 15 and 20, as we pointed out, even if  
9 limitations of Bauman were really — any of the disclosures in Bauman were  
10 combined with Huffer, you still wouldn't get present invention.

11           I might add that Bauman is concerned with also coatings having  
12 a binder with nano particles.

13           So you have a coating with nano particles on a substrate. So I  
14 mean, the present invention, even though there hasn't been a rejection per se,  
15 it is over and it is patentable over either one of them.

16           There is really not much more to add here, and certainly I  
17 would be happy to answer any questions you might have.

18           JUDGE GARRIS: What would you want us to look at in claim  
19 17 when trying to decide that claim?

20           MR. PITLICK: Well, okay. Well, claim 17 says that the  
21 molding is capable of being in softened or molten form. So it has got to —  
22 the — the — the apparatus in Huffer, in which the protuberance — coating is  
23 coated on has to be capable of being soft. If it can't be, then obviously  
24 Huffer does not anticipate it.

25           In Huffer the apparatus again being coated doesn't appear to  
26 have organic materials. It's got a metal layer, a metal polymer dispersion

1 layer, so it can have polymers in the layer, but it is not part of the underlying  
2 apparatus itself.

3 So, it might meet the terms as far as we can see.

4 JUDGE GARRIS: So is there any other issue that you would  
5 like to bring to our attention?

6 MR. PITLICK: No.

7 JUDGE GARRIS: They are pretty straight forward issues in  
8 this particular matter.

9 MR. PITLICK: I think so.

10 JUDGE GARRIS: Mr. Kratz, any questions on the issues?

11 JUDGE KRATZ: No questions.

12 JUDGE GARRIS: Mr. Colaianni?

13 JUDGE COLAIANNI: No questions.

14 JUDGE GARRIS: We thank you very much for your  
15 presentation.

16 MR. PITLICK: Thank you.

17 Whereupon, the proceedings were concluded at 1:37 p.m.